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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,838	06/29/2001	Dwight Marcus	NPOWR-3-US	5872
45722 7590 08/20/2007 PLEVY, HOWARD & DARCY, P.C. P.O. BOX 226 Fort Washington, PA 19034			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 08/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/896,838

Applicant(s)

MARCUS, DWIGHT

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 148-162 is/are pending in the application.
- 4a) Of the above claim(s) 158-162 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 148-157 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/1/2007 has been entered.

### ***Election/Restrictions***

2. **Newly submitted claims 158-162 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:**

Claims 158-162 and the original claims are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of claims 158-162 has separate utility such as verifying the acquisition of non-unitary products. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found

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allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 158-162 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 148 and 151 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Regarding claim 148**, this claim recites the limitation “at least one of said plurality of signifiers does not have significance in connection with the provided information”. This limitation is not recited in the specification and is considered to be new matter.

**Regarding claim 151**, this claim recites the limitation “said text form signifiers not pertaining to information on the topic”. This limitation is not recited in the specification and is considered to be new matter.

4. **Claim 153 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Regarding claim 153**, this claim recites the limitations “the text form information comprises instructional material relating to a product or service” and “after said step of verification...making available to the information customer support associated with the product or service in a first manner...” The claim appears to comprise the steps of providing, verifying, and then after the verification, making product support available to the customer. This process is not recited in the specification. According to the specification, the consumer may read a product manual to obtain a toll-free customer service number (Page 26). There appears to be no step of verification in this

embodiment. If the consumer finds the toll-free number, then the product support is made available by calling the number without any verification required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1, 148, 151, and 152 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 1**, this claim recites the limitation “providing said provided information”. This is unclear how to provide the already provided information. Is the information being provided twice?

**Regarding claim 1**, this claim recites the limitation “said first signifiers”. There is insufficient antecedent basis for this limitation in the claim.

**Regarding claim 148**, this claim recites the limitation “at least one of said plurality of signifiers does not have significance in connection with said provided information”. However, claim 1 (from which this claim depends) recites “providing said provided information having a plurality of signifiers inserted therein”. If signifiers are inserted in the provided information, this association appears to be rather significant. Examiner is unclear as to how a signifier could have no significance to provided information when the signifier is significantly inserted into the provided information.

**Regarding claim 151**, this claim recites the limitation “said text form signifiers not pertaining to information on the topic”. However, this claim also recites “text form

information having a plurality of text form signifiers inserted therein". If text form signifiers are inserted in the text form information, this association would appear to pertain to the topic of the text form information. Examiner is unclear as to how a text form signifier could not pertain to a topic of text form information when the signifier is significantly inserted into the text form information.

**Regarding claim 152**, this claim recites the limitation "the text form information has instructions for indicating knowledge of the signifier". This appears to be a topic of the text form information. However, claim 151 from which this claim depends recites the limitation ""said text form signifiers not pertaining to information on the topic". It is unclear how text form information may contain instructions for indicating knowledge of signifiers that are supposed to have nothing to do with the text form information in the first place.

6. **Claims 1 and 151 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.** See MPEP § 2172.01.

**Regarding claims 1 and 151**, these claims recite the limitations "determining whether an indication received" and "based on an indication received". The only steps of claim 1 are providing, providing, and determining. The only steps of claim 151 are providing and verifying. There are no actively claimed steps of receiving an indication recited in either of the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**7. Claims 1 and 148-150 are rejected under 35 U.S.C. 102(b) as being anticipated by McGregor (U.S. Patent No. 5,236,200).** McGregor teaches a method of providing an incentive that includes all of the limitations recited in the above claims.

**Regarding claim 1**, McGregor teaches providing information to an information consumer (treasure hunt game card) (Figure 1) with a plurality of signifiers enclosed therein (clues) (Column 1, Lines 59-63). A signifier use instruction is inherent when the treasure hunt game is provided (follow the clues to get to the treasure). Should the information consumer display sufficient knowledge of the clues, they will receive an incentive (the treasure/gift) (Column 1, Lines 59-63).

**Regarding claim 148**, the picture on the front of the treasure hunt card (Figure 1) does not appear to have any notable significance to the clues on the card and vice versa.

**Regarding claims 149 and 150**, McGregor teaches anagrams and puzzles as clues (Column 3, Lines 14-22). This represents a conversion code for conversion of the clue to another type of information that may be used to locate and claim the incentive (contact information).



8. **Claims 151-155 are rejected under 35 U.S.C. 102(a) as being anticipated by Sony (Owner's Manual, Sony Video Cassette Recorder Model SLV-662HF, 1999).**

Sony teaches providing access to a toll-free phone number that includes all of the limitations recited in the above claims.

**Regarding claims 151 and 153-155**, Sony teaches providing text form information (the manual itself) having text form signifiers enclosed within (the toll-free phone number at the bottom of the last page). If the consumer reviews the Sony manual and finds the phone number, then the customer is rewarded with toll-free customer service. However, if the customer does not sufficiently review the manual to find the toll-free phone number, they will inherently need to seek other options for customer service, such as driving to a retail establishment (which would inherently cost more than a toll-free number would).

**Regarding claim 152**, Sony recites "If you have any questions about this product, you may call" (bottom of the last page). This reads on "instructions for indicating knowledge of the signifier".

9. **Claims 151, 156, and 157 are rejected under 35 U.S.C. 102(b) as being anticipated by Benson (U.S. Patent No. 3,926,325).** Benson teaches a method of providing access to medication that includes all of the limitations recited in the above claims.

**Regarding claims 151, 156, and 157**, Benson teaches providing information on the side of bottles (provided text form information) including instructions about how to open the child-proof cap (text form signifiers) (Figure 3, Column 1, Lines 26-37). The bottle of Benson is meant for medicine (Column 2, Lines 39-41), and thus the text form provided information are medical instructions. Should the consumer display sufficient knowledge of the signifiers, they may use the signifiers (instructions) to gain access to the medication within the bottle.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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